

## **REMARKS**

Applicant has carefully reviewed the Office Action mailed December 28, 2007 and offers the following remarks to accompany the above amendments.

### ***Status of the Claims***

Claims 1-7 were previously cancelled. Claims 16 and 17 have been cancelled. Applicant has amended claims 18 and 19 to depend from claim 20. Applicant has amended claims 26 and 27 to correct antecedent basis. Applicant has added new claims 32-34. Accordingly, claims 8-15 and 18-34 are pending.

### ***Rejection Under 35 U.S.C. § 103(a) – Spurgat and Headley***

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0173273 A1 to Spurgat et al. (hereinafter “Spurgat”) in view of U.S. Patent Application Publication No. 2002/0194260 A1 to Headley et al. (hereinafter “Headley”). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. If the Patent Office cannot establish obviousness, the claims are allowable.

Spurgat teaches a system where a computing platform (Figure 1, element 103) or a set-top box (STB) (Figure 5, element 107) operates as an audio gateway for a number of digital audio players (Figure 1, elements 115 and 116; Figure 5, elements 110 through 114). In the embodiment using the STB (107), the STB (107) operates to control the digital audio players (110 through 114), act as a cache of digital audio content for the digital audio players (110 through 114), and operates as a gateway to the Internet to enable the digital audio players (110 through 114) to access additional digital audio content and other information from a server (Figure 1, element 100).<sup>1</sup>

Headley teaches a multimedia playlist including a number of media items, where the media items are different types of content and are available for playback on different player devices. For example, a multimedia playlist may include a first song from a CD in a first CD player, a second song from a CD in a second CD player, and a movie from a DVD in a DVD

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<sup>1</sup> Spurgat, ¶ 45 through ¶ 48.

player. A set-top device (Figure 1, element 106) is connected to each of the audio and video devices (102), which in the example above are the first and second CD players and the DVD player. The set-top device (106) executes the multimedia playlist to thereby cause the first and second CD players and the DVD player to play the first and second songs and the movie in the sequence defined by the multimedia playlist.

Regarding claim 8, the combination of Spurgat and Headley fails to teach or suggest a remote control for controlling a set-top box, where the remote control is operative to: (1) obtain one of a plurality of playlists from a playlist server, (2) facilitate selection of a media item from the playlist, and (3) direct the set-top box to request the media item from a content server and cause the media item to play on an associated rendering device. In rejecting claim 8, the Patent Office admitted that Spurgat fails to teach a remote control for controlling a set-top box that is operative to perform the claimed functions.<sup>2</sup> Note that the Patent Office did state that the STB (107) of Spurgat performs the functions of the claimed remote control, namely, obtaining one of a plurality of playlists from a playlist server, facilitating selection of a media item from the playlist, and directing the set-top box to request the media item from the content server and cause the media item to play on a rendering device.<sup>3</sup> While Applicant disagrees, even if the STB (107) of Spurgat performs the functions of the claimed remote control, Spurgat fails to teach or suggest a *remote control* for controlling the set-top box that performs those functions.

Headley fails to correct this deficiency. In rejecting claim 8, the Patent Office referenced paragraphs 24 and 45 of Headley. While paragraph 24 of Headley teaches an input device (107), which may be a remote control device, nothing in paragraph 24, paragraph 45, or any other part of Headley teaches or suggests that the input device (107) performs the claimed functions of: obtaining one of a plurality of playlists from a playlist server, facilitating selection of a media item from the playlist, and directing the set-top box to request the media item from a content server and cause the media item to play on an associated rendering device.

More specifically, the input device (107) of Headley simply operates as a conventional device for controlling a device such as the set-top device (106).<sup>4</sup> Thus, even if the STB (107) of Spurgat performs the functions of the claimed remote control, which Applicant does not concede, the combination of Spurgat and Headley teaches nothing more than a system including

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<sup>2</sup> Office Action mailed December 28, 2007, pages 3 and 4.

<sup>3</sup> *Id.* at page 3.

<sup>4</sup> See Headley, ¶ 24, lines 3-5.

the STB (107) of Spurgat and a remote control for controlling the set-top box. The combination fails to teach or suggest a *remote control* operative to obtain one of a plurality of playlists from a playlist server, facilitate selection of a media item from the playlist, and direct the set-top box to request the media item from the content server and cause the media item to play on a rendering device. As such, claim 8 is allowable.

***Rejection Under 35 U.S.C. § 103(a) – Spurgat, Headley, and Edwards***

Claims 9-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Spurgat in view of Headley further in view of U.S. Patent No. 6,946,988 B2 to Edwards et al. (hereinafter “Edwards”). Applicant respectfully traverses. The standards for obviousness are set forth above. Claims 9-15 are dependent claims based upon claim 8. As such, claims 9-15 are allowable for at least the same reasons set forth above with respect to claim 8. However, Applicant reserves the right to further address the rejection of claims 9-15 in the future, if needed.

***Rejection Under 35 U.S.C. § 102(e) - Headley***

Claims 16, 17, and 19-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Headley. Applicant respectfully traverses. For a reference to be anticipatory, the reference must disclose each and every claim element. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. The requirement that each and every element be disclosed in the manner claimed is a rigorous standard that the Patent Office has not met in this case.

Applicant has cancelled claims 16 and 17. Applicant has amended claim 19 to be dependant upon claim 20. As such, claim 19 is allowable for at least the same reasons set forth below with respect to claim 20.

Regarding claim 20, first, Headley fails to expressly or inherently disclose receiving a playlist at a portable wireless device. In order to show this element of claim 20, the Patent Office relied on paragraphs 10 and 11 of Headley.<sup>5</sup> However, paragraphs 10 and 11 of Headley discuss a multimedia playlist and method of playing different types of audio and video media on different audio and video devices. Paragraphs 10 and 11 of Headley do not disclose receiving a playlist at *a portable wireless device*. Referring to Figure 1, Headley discloses a system (100) including a set-top device (106). The set-top device (106) may be controlled by an input device

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<sup>5</sup> Office Action mailed December 28, 2007, page 9.

(107), such as a remote control. A multimedia playlist is stored on the set-top device (106) and is executed by the set-top device (106) in order to provide playback of a number of different types of audio and video media from audio-video devices (102) in a sequence defined by the multimedia playlist. However, even if the set-top device (106) receives the multimedia playlist from an external source, which Applicant does not concede, the set-top device (106) of Headley is not a portable wireless device. As such, Headley fails to disclose receiving a playlist at a portable wireless device.

Second, Headley fails to expressly or inherently disclose requesting, from a content server, a media item selected from a playlist at a portable wireless device. In order to show this element of claim 20, the Patent Office relied on paragraph 35, and more specifically the “information downloaded from [sic] remote database” discussed in paragraph 35.<sup>6</sup> However, as stated in paragraph 35 of Headley, the information downloaded from the remote database application (226) is information that can be displayed to the user to assist the user in selecting media items to be included in a multimedia playlist.<sup>7</sup> This information may be a name of the person performing a song on a CD or a play length of the song.<sup>8</sup> Thus, the information obtained from the remote database application (226) in Headley is not media items, but rather information describing media items. As such, Headley fails to disclose requesting *a media item* from a content server.

Lastly, Headley fails to expressly or inherently disclose receiving the requested media item at a control device in communication with the content server and the portable wireless device. In order to show this element of claim 20, the Patent Office again relied on paragraph 35 and more specifically the “information downloaded from [sic] remote database” discussed in paragraph 35.<sup>9</sup> However, as discussed above, the information downloaded from the remote database application (226) of Headley is information about media items rather than the media items themselves. For example, Headley gives the example of a song (media item) where the information obtained from the remote database application (226) is a name of the performer of the song or a play length of the song. As such, Headley fails to disclose receiving the media item requested from the content server.

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<sup>6</sup> *Ibid.*

<sup>7</sup> Headley, ¶ 35, lines 3-5.

<sup>8</sup> *Id.* at lines 5-7.

<sup>9</sup> Office Action mailed December 28, 2007, page 9.

In light of the discussion above, Headley fails to disclose: (1) receiving a playlist at a portable wireless device, (2) requesting, from a content server, a media item selected from the playlist at the portable wireless device, and (3) receiving the requested media item at a control device in communication with the content server and the portable wireless device. Since Headley fails to disclose each and every element of claim 20, claim 20 is allowable over Headley.

Regarding claim 21, Headley fails to disclose the method of claim 20 wherein the portable wireless device comprises a remote control operable to affect functionality of the control device. In order to reject claim 21, the Patent Office relied on paragraph 24 of Headley.<sup>10</sup> In paragraph 24, Headley discloses an input device (107) for controlling the set-top device (106). However, nothing in paragraph 24 or any other section of Headley discloses: (1) receiving a playlist at the input device (107), (2) requesting, from a content server, a media item selected from the playlist at the input device (107), and (3) receiving the requested media item at the set-top device (106). As such, claim 21 is allowable over Headley.

Claims 22 and 23 are dependent claims based upon claim 20. As such, claims 22 and 23 are allowable for at least the same reasons set forth above with respect to claim 20. However, Applicant reserves the right to further address the rejections of claims 22 and 23 in the future, if needed.

Regarding claim 24, Headley fails to disclose receiving the playlist from a playlist server. In order to reject claim 24, the Patent Office relied on paragraph 25 of Headley, and more specifically on the information downloaded from a remote database.<sup>11</sup> However, as discussed above, the information obtained from the remote database application (226) of Headley is information to assist the user in selecting media to include in a multimedia playlist.<sup>12</sup> More specifically, for media items (e.g., songs and videos) available from local audio-video devices (102), the set-top device (106) may obtain information describing the media items from the remote database application (226). This information may be, for example, a name of a person performing a song, and is used to assist the user in creating a multi-media playlist at the set-top device (106). Headley does not disclose receiving a playlist from a playlist server. As such, claim 24 is allowable over Headley.

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<sup>10</sup> *Id.* at page 10.

<sup>11</sup> *Ibid.*

<sup>12</sup> Headley, ¶ 035, lines 3-7.

Claims 25 and 26 are dependent claims based upon claim 20. As such, claims 25 and 26 are allowable for at least the same reasons set forth above with respect to claim 20. However, Applicant reserves the right to further address the rejections of claims 25 and 26 in the future, if needed.

***Rejection Under 35 U.S.C. § 103(a) –Headley and Levitt***

Claims 18 and 27-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Headley in view of U.S. Patent Application Publication No. 2002/0151327 A1 to Levitt (hereinafter “Levitt”). Applicant respectfully traverses. The standards for obviousness are set forth above.

Regarding claim 18, the combination of Headley and Levitt fails to teach or suggest receiving a second media item at the portable wireless device from the content server and playing the second media item at the portable wireless device wherein the portable wireless device is operative to concurrently control playback of the requested media item at the rendering device via the control device. In rejecting claim 18, the Patent Office first stated that Headley teaches receiving a second media item from the network.<sup>13</sup> Applicant respectfully disagrees. As discussed above, Headley discloses receiving information from a remote database. However, this information is information such as the name of a person performing a song that assists the user in creating a multimedia playlist. Headley fails to teach or suggest receiving media items from a remote source. The Patent Office went on to state that Headley fails to teach playing the second media item on the portable wireless device and then relied on Levitt to show this element of claim 18.<sup>14</sup> Levitt discloses a system where a handheld device (22), such as a PDA, can be used to control multiple entertainment devices (24). However, Levitt fails to disclose receiving a media item at the handheld device (22) from a content server and playing the second media item at the handheld device (22) while the handheld device (22) is concurrently operative to control playback of a media item at one of the entertainment devices (24). As such, Levitt fails to correct the deficiencies of Headley with respect to claim 18. Therefore, claim 18 is allowable.

Regarding claim 27, the combination of Headley and Levitt fails to teach or suggest a remote control having a display that is operative to display a *playlist* of identifiers associated

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<sup>13</sup> Office Action mailed December 28, 2007, page 11.

<sup>14</sup> *Id.* at pages 11 and 12.

with respective media items and direct the set-top box to *request a media item* associated with an identifier selected from the playlist *from a remote content server*. In rejecting claim 27, the Patent Office first stated that Headley teaches a remote control operative to direct the set-top box to request a media item associated with a selected identifier from a content server.<sup>15</sup> However, Headley discloses an input device (107) for controlling the set-top device (106). The set-top device (106) executes a multimedia playlist to play different types of media items from multiple audio-video devices (102) such as CD and DVD players. Headley fails to teach or suggest that the input device (106) can be used to direct the set-top device (106) to request a media item from a remote content server. Levitt fails to correct this deficiency. In Levitt, a handheld device (22) is used to control a number of entertainment devices (24). One type of entertainment device (24) discussed in Levitt is a television or set-top box. With respect to television content, electronic programming guide (EPG) information may be obtained by the handheld device (22) and displayed to the user. The user can then select a television show. In response, the handheld device (22) directs the television/set-top box to *tune to* the corresponding television channel. Levitt fails to teach or suggest that the handheld device (22) directs an entertainment device (24) to *request a media item from a content server*.

Second, in rejecting claim 27, the Patent Office admitted that Headley fails to teach a remote control having a display and operative to display a playlist of identifiers, each being associated with a respective media item. In order to show this element of claim 27, the Patent Office relied on Figure 4D and paragraph 214 of Levitt.<sup>16</sup> However, in Figure 4D and paragraph 214, Levitt discloses a PDA that displays EPG information for a television service to which the user is subscribed, rather than a playlist. More specifically, the PDA displays a number of television programs that are airing at that particular time, rather than a playlist. For example, referring to Figure 4D, the user could not play each of the listed television programs in sequence, as would be possible with the playlist of the claimed invention, because the television programs are all playing at the same time.

Therefore, the combination of Headley and Levitt fails to teach or suggest a remote control that: (1) displays a *playlist* of identifiers and (2) directs a set-top box to *request a media*

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<sup>15</sup> *Id.* at page 13.

<sup>16</sup> *Ibid.*

*item* corresponding to an identifier selected at the remote control *from a content server*. As such, claim 27 is allowable.

Claims 28 and 29 are dependent claims based upon claim 27. As such, claims 28 and 29 are allowable for at least the same reasons set forth above with respect to claim 27. However, Applicant reserves the right to further address the rejections of claims 28 and 29 in the future, if needed.

Regarding claim 30, the combination of Headley and Levitt also fails to teach or suggest a remote control that is further operative to receive a list identifying a plurality of playlists, select the playlist from a plurality of playlists, and obtain the playlist from a playlist server. In order to reject claim 30, the Patent Office relied on paragraphs 84, 149, and 257 of Levitt.<sup>17</sup> Nowhere in Levitt is it taught that the handheld device (22) receives a list identifying a plurality of playlists, selects a playlist from the list, and then obtains the selected playlist from a playlist server. As such, claim 30 is allowable.

Claim 31 is a dependent claim based upon claim 27. As such, claim 30 is allowable for at least the same reasons set forth above with respect to claim 27. However, Applicant reserves the right to further address the rejection of claim 30 in the future, if needed.

#### ***New Claims 32-34***

Applicant has added new claims 32-34. Support for these new claims can be found, for example, in paragraphs 105 and 108 through 111 on pages 22 and 23 of Applicant's specification. As such, no new matter has been added.

Claims 32 and 33 are dependent claims based upon claim 20. As such, claims 32 and 33 are allowable for at least the same reasons set forth above with respect to claim 20. However, Applicant reserves the right to further address the rejections of claims 32 and 33 in the future, if needed.

Claim 34 is a dependent claim based upon claim 27. As such, claim 34 is allowable for at least the same reasons set forth above with respect to claim 27. However, Applicant reserves the right to further address the rejection of claim 34 in the future, if needed.

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<sup>17</sup> *Id.* at page 14.



***Conclusion***

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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By:

A handwritten signature in black ink, appearing to read 'R. Chad Bevins', written over a horizontal line.

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